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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Mamoru USAMI et al.

Group Art Unit: 1774

Application No.: 10/501,508

Examiner: E. MULVANEY

Filed: August 27, 2004

Docket No.: 120230

For: METHOD FOR MANUFACTURING DISC-SHAPED OPTICAL RECORDING
MEDIUM AND DISC-SHAPED OPTICAL RECORDING MEDIUM

REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Claim 15 is pending in this application. In reply to the May 25, 2007 Office Action, reconsideration of the rejection is respectfully requested in light of the following remarks.

Claims 1-14, 16 and 17 (Group I) and claim 15 (Group II) are subject to a Restriction Requirement. As indicated in a May 21 telephone conversation with Examiner Mulvaney, Applicants elect Group II, claim 15, with traverse.

Applicants respectfully assert that the Requirement is improper under the rules of practice in PCT national stage applications, because the appropriate unity of invention standards have not been properly applied by the Patent Office. In PCT national stage applications, the Examiner may issue a restriction-type Requirement if no unity of invention exists. However, the Examiner must state why there is no "single general inventive concept." See MPEP §1893.03(d). Therefore, a single application may include one invention, or more than one invention if the inventions are "linked as to form a single general inventive concept."

Id. (emphasis added). If multiple inventions are included in the application, they are deemed to be linked if there exists a "technical relationship among the inventions that involves at least one common or corresponding special technical feature." Id.

The Office Action asserts that unity of invention does not exist, because Groups I and II "lack the same or corresponding special technical features." Specifically, the Office Action asserts on page 2 that Groups I and II lack the same or corresponding special technical features because "the medium of Group II does not require the special technical [feature] of removing a center part of the substrate after the resin layer is formed. The medium may be formed by laminating two layers together which have differing center hole diameters." Applicants respectfully submit that this is not the proper standard in PCT national stage applications. As noted above, restriction is improper where the claims share at least one common or corresponding technical feature. At least one common special technical feature includes the structural features produced in the optical recording medium. Compare, the subject matter of claim 1 with the subject matter of claim 15. See, also, Example 3, §10.23 of the PCT International Search and Preliminary Examination Guidelines. Accordingly, withdrawal of the Restriction Requirement and rejoinder of claims 1-14, 16 and 17 are respectfully requested.

Claim 15 is rejected under 35 U.S.C. §102(e) as being anticipated by either U.S. Patent Application Publication No. 2006/0023618 to Tomiyama et al. ("Tomiyama"), or U.S. Patent Application Publication No. 2006/0177534 to Usami et al. ("Usami"). These rejections are respectfully traversed.

The §102(e) rejections should be withdrawn because neither Tomiyama nor Usami are prior art to the pending application.

The pending application is a PCT national stage application. Accordingly, the pending application has an effective U.S. filing date of January 17, 2003 (the international filing date). See, 35 U.S.C. §363.

Tomiyama has §102(e) prior art date of March 10, 2005 (U.S. filing date). Usami has a §102(e) prior art date of August 22, 2005 (U.S. filing date). See, MPEP §706.02(f)(1)(C)(2). Accordingly, these references are not prior art against the pending application and the rejections of claim 15 should be withdrawn.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claim 15, and rejoinder and prompt allowance of claims 1-14, 16 and 17 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: July 20, 2007

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